

REMARKS

Claims 26, 28-56 and 58-80 are pending. With this Response, Applicants amend claims 33, 43, 55, 66, and 78, and add new claims 81-86. All pending claims are shown in the detailed listing above.

Claims

Applicants respectfully note that there was a typographical error in claim 26 as recited in the Response filed on August 3, 2006. In particular, in that Response, the last clause in claim 26 recited “wherein *data* information and time information of contents of the XML electronic document are used as the version value.” (Emphasis added). That clause should recite “wherein *date* information and time information of contents of the XML electronic document are used as the version value.” (Emphasis added). The correct wording of “date” appears in the recitation of claim 26 in the Preliminary Amendment filed on February 16, 2005.

Since the appearance of the term “data” instead of “date” in the prior recitation of claim 26 in the August 3, 2006 Response was a typographical error, the Applicants have presented claim 26 in its correct form in this Response without indicating that this is an amendment to the claim (which it is not).

Specification

The specification stands objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o). The Examiner states, “Correction of the following is required: Specification does not disclose the term “lower element” and “upper element” as recited in claims (see independent claims along with appropriate dependent claims).” Applicants respectfully traverse.

The specification of the Application as filed describes lower and upper structures, for example, with reference to FIGS. 2 through 5. Referring to these figures, the Application

recites, “FIG. 2 is a diagram schematically showing a general method of creating the XML-based electronic document. As shown in FIG. 2, each parenthesis is indicative of a number of lower structures that can be transited to upper structure.” Application, paragraph [49]. The Application also recites, “A second embodiment of the method for versioning the electronic document based on XML according to the present invention, when a version value of lower structure is corrected, a version value of an upper structure is changed to the latest information (e.g., most recently changed) among the version values of corresponding lower structures.” Application, paragraph [51].

The term “element” means a “constituent part.” *Merriam-Webster’s Collegiate Dictionary*, 10th ed. (1998), p.373 (excerpt attached for the Examiner’s convenience). As discussed above, the Application describes that the lower and upper structures can be constituent parts of an electronic document, which may be, for example, XML-based. Thus, the Application as filed provides support for the terms “lower element” and “upper element.”

Accordingly, since the terms “lower element” and “upper element” are supported in the specification of the Application, Applicants respectfully request that this objection to the specification be withdrawn.

Claim Objections

Claim 28 is objected to because of a purported informality. According to the Examiner, “This claim recites the term ‘lower element’. The specification makes no mention of a ‘lower element’, however the specification recites the term ‘lower structure’.” Applicants respectfully traverse.

As discussed above, the specification provides support for “lower element” as well as “upper element.” As such, Applicants respectfully request that the objection to claim 28 be withdrawn.

Claim Rejections – 35 USC § 112

Claim 28 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states, “The claim recites the terms ‘*lower element*’ and ‘*upper element*’. It is unclear to the examiner as to how the applicant identifies/distinguishes the ‘*lower element*’ of a document from the ‘*upper element*’ of the document. Clarification is required in the matter.” Applicants respectfully traverse.

Claim 28 in its present form is not indefinite. There is nothing unclear about the language of claim 28 itself. And the Examiner admits as much in the rejection. In rejecting claim 28 under 35 U.S.C. § 112, second paragraph, the Examiner articulates a reason which is unrelated to definiteness—i.e., “It is unclear to the examiner ***as to how the applicant identifies/distinguishes*** the ‘*lower element*’ of a document from the ‘*upper element*’ of the document.” (emphasis in bold and italics added). The Examiner does not say that the language of claim 28 is unclear or indefinite. Instead, what the Examiner says is that it is unclear to him “*as to how the applicant identifies/distinguishes*” two claimed elements of a document. Such a reason is not an appropriate basis for a rejection under 35 U.S.C. § 112, second paragraph. Thus, Applicants respectfully request that the rejection of claim 28 under 35 U.S.C. § 112, second paragraph be withdrawn.

Claims 40-42, 52-54, 63-65, and 75-77 also rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. According to the Examiner, “These claims recite the terms ‘*lower structure*’ and ‘*upper structure*’. It is unclear to the examiner as to how the applicant identifies/distinguishes the ‘*lower element*’ of a document from the ‘*upper element*’ of the document. Clarification is required in the matter.” Applicants respectfully traverse.

There is nothing unclear or indefinite about claims 40-42, 52-54, 63-65, and 75-77. The reason which the Examiner gives for rejecting these claims under 35 U.S.C. 112, second paragraph, is the same as given for rejecting claim 28. As discussed above, such a reason is

not an appropriate basis for a rejection under 35 U.S.C. § 112, second paragraph. Applicants thus respectfully request that the rejection of claims 40-42, 52-54, 63-65, and 75-77 under 35 U.S.C. § 112, second paragraph be withdrawn.

Claim Rejections – 35 USC § 103

Claims 26, 28-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Azami et al. (Pub. No. 2003/0009472 A1) in view of Kim et al. (Pub. No. 2004/0015369 A1), further in view of Anderson et al. (Patent No. 5,499,365). Applicants respectfully traverse.

This is a situation in which the Examiner has used impermissible hindsight to reconstruct Applicants' claimed invention. The Examiner's rejection relies on no less than three references in order to reject even the Applicant's independent claim 26. Azami et al., the primary reference relied upon by the Examiner, is deficient in so many ways. In the Examiner's own words, "Azami does not expressly [sic] a document receiving device coupled to the document storage device, wherein the document receiving device is configured to process one of multiple versions of the XML electronic document according to a version value of the versions of the XML electronic document;" and "Azami...does not expressly disclose/teach data information and time information of contents of the XML, electronic document are used as the version value."

In order to provide teaching or suggestion for those elements of Applicants' claimed invention which are admittedly lacking in Azami et al., the Examiner cites two additional references—Kim et al. and Anderson et al. These three references—Azami et al., Kim et al., and Anderson et al.—are not even in the same technology area or field. Azami et al. concerns structured metadata. Kim et al. covers a workflow system for document management, in particular, for insurance contracts. And Anderson et al. relates to object-oriented computing. One of ordinary skill in the art would not turn to such diverse fields for teachings or suggestions.

In view of the many deficiencies of the primary reference and the need for an abundance of additional references from disparate fields, the only way to make this rejection of Applicants' claims would be to use the Applicants' own teachings as a blueprint. This constitutes impermissible hindsight. As such, the rejection is improper and cannot stand.

Furthermore, even assuming *arguendo* that the references cited by the Examiner are appropriate prior art, the combination of these references is improper. The Examiner gives the following reasons for combining Azami et al. with Kim et al. and Anderson et al.: "[I]t would have been obvious to a person of ordinary skill in the art to combine Azami, in view of Kim, for the benefit a transmission/receiving system, such as a digital television broadcast system, to be able to identifying [sic] the units (electronic document) by referring to the identification information (version value)..." and "[I]t would have been obvious to a person of ordinary skill in the art to combine Azami, in view of Kim, with Anderson for the benefit maximal reuse of information, allowing selection of a unique version of a document based on time (Anderson column 2, lines 28-29)." Applicants strongly disagree.

Because the various references cover such disparate technology—i.e., object-oriented programming, structured metadata, and insurance contracts—one of ordinary skill would not think to combine them in any way, much less the way in which the Examiner proposes. For example, one of ordinary skill would not consider the objects disclosed in Anderson et al. to be structured metadata like that disclosed in Azami et al., nor vice versa. Furthermore, one of ordinary skill in the art would not view the insurance contracts disclosed in Kim et al. in the same way as the structured metadata of Azami et al., nor vice versa. As such, one of ordinary skill would not think or be motivated to use the techniques of Anderson et al. or Kim et al. in an application such as Azami et al.

In addition, the references teach away from any combination to form the Applicants' claimed invention. In object-oriented programming as disclosed in Anderson et al., the objects are not considered to be part of any larger structure (such as a document). Instead, the objects are discrete units. Anderson et al. states, "An object is a data structure, also referred to as a "frame", and a set of operations or functions, also referred to as "methods", that can access that data structure." Anderson et al., col. 1, lines 20-22. Likewise, the

insurance contracts disclosed in Kim et al. are each discrete units and not part of a larger structure. In contrast, the MPEG-7 tree structure as disclosed in Azami et al. is divisible into upper-ranked structured metadata and lower-ranked structure metadata. Thus, the object-oriented programming of Anderson et al. and the insurance contract system of Kim et al.—neither of which handle structured data—are inconsistent with the teachings of Azami et al.

For at least the reasons discussed above, the rejection of claims 26 and 28-35 under 35 U.S.C. § 103(a) as being unpatentable over Azami et al. in view of Kim et al., and further in view of Anderson et al. cannot stand. Applicants respectfully request that this rejection of claims 26 and 28-35 be withdrawn and these claims be allowed.

Claims 36-39, 46-51, 58-62, and 69-74 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson et al. in view of Barker et al. (Pub. No.: 2002/0143976 A1). Applicants respectfully traverse.

As with the rejection of claims 26 and 28-35, here the Examiner has used impermissible hindsight to reconstruct Applicants' claimed invention. The references cited by the Examiner are in disparate fields of technology. Anderson et al. relates to object-oriented computing, and Barker et al. covers metadata. One of ordinary skill in the art would not turn to such diverse fields for teachings or suggestions. Furthermore, the combination of these references is improper. Because Anderson et al. and Barker et al. cover such disparate technology—i.e., object-oriented programming and metadata—one of ordinary skill would not think to combine them in any way, much less the way in which the Examiner proposes. For example, one of ordinary skill would not consider the objects disclosed in Anderson et al. to be metadata liked that disclosed in Barker et al., nor vice versa. As such, one of ordinary skill would not be motivated to use the techniques of Barker et al. in an application such as Anderson et al. The only way to combine Anderson et al. and Barker et al. make this rejection of Applicants' claims would be to use the Applicants' own teachings as a blueprint, which is improper. Accordingly, the rejection of claims 36-39, 46-51, 58-62, and 69-74 under 35 U.S.C. § 103(a) as being unpatentable over Anderson et al. in view of Barker et al. cannot stand.

For at least the reasons discussed above, Applicants respectfully request that the rejection of claims 36-39, 46-51, 58-62, and 69-74 under 35 U.S.C. § 103(a) be withdrawn and these claims be allowed.

Claims 40-45, 52-56, 63-68, and 75-80 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson et al. in view of Barker et al., further in view of Azami et al. Applicants respectfully traverse.

Here again, the Examiner has used impermissible hindsight to reconstruct Applicants' claimed invention. The Examiner's rejection relies on no less than three references, with the Examiner's primary reference, Anderson et al., being in a completely different field of technology from the other references, Barker et al. and Azami et al. As already discussed, Anderson et al. relates to object-oriented computing, whereas Barker et al. and Azami et al. cover metadata. One of ordinary skill would not think to would not think or be motivated to use the techniques of Barker et al. or Azami et al. in an application such as Anderson et al. Accordingly, the rejection of claims 40-45, 52-56, 63-68, and 75-80 under 35 U.S.C. § 103(a) as being unpatentable over Anderson et al. in view of Barker et al., further in view of Azami et al. cannot stand.

For at least the reasons discussed above, Applicants respectfully request that the rejection of claims 40-45, 52-56, 63-68, and 75-80 under 35 U.S.C. § 103(a) be withdrawn and these claims be allowed.

New Claims

Applicants respectfully submit that new claims 81-86 are fully supported by the Application as filed, add no new matter, and are allowable.



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19

CONCLUSION

Applicants respectfully request that the pending claims be allowed and the case passed to issue. Should the Examiner wish to discuss the Application, it is requested that the Examiner contact the undersigned at (415) 772-7428.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

1/12/07

Date

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